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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,974	10/24/2003	Richard Reisman	17245-009	1713
54205 7590 03/31/2009 CHADBOURNE & PARKE LLP 30 ROCKEFELLER PLAZA NEW YORK, NY 10112				
EXAMINER NGUYEN, THUY-VI THI				
ART UNIT 3689		PAPER NUMBER		
MAIL DATE 03/31/2009		DELIVERY MODE PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/692,974

**Applicant(s)**

REISMAN, RICHARD

**Examiner**

THUY VI NGUYEN

**Art Unit**

3689

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 October 2003.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-154 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☒ Claim(s) 1-154 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)  
3) ☐ Information Disclosure Statement(s) (PTO/SE/US)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C.

121:

- I. Claims 1-118, 119-120, 141-146, and 154 drawn to method of operating an electronic market place for the development of inventions, classified in class 705, subclass 01 or 10.
- II Claims 121, 122-133, 150-152, and 153, drawn to method of operating a marketplace for the development of inventions, classified in class 705, subclass 01.
- III. Claims 134-140, drawn to method operating a collaborative support system, classified in class 705, subclass 07.
- IV. Claims 147-149, drawn to method of operating an electronic idea development community, classified in class 705, subclass 08.

As for Groups I and II, although Examiner classified both Groups in 705/1, this alone is not sufficient to prove lack of serious burden. Referring to MPEP § 808.02 an Examiner may establish burden from one of the following: 1) Separate classification thereof, 2) Separate status in the art when they are classifiable together, or 3) a different field of search. Even though the classification is the same and the field of search is the same, there may be adequate burden if there is a clear indication of separate future classification. The present application is classified in business method miscellaneous, which is currently undergoing

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reclassification and is a very broad classification. Although the application has been classified as 705/1, this is a relatively new class/subclass which is undergoing reclassification. Here, Examiner believes there to be a sufficient different field of search due to the following reasons

2. Inventions in **Groups I and II** are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the invention of group I is directed to method of operating an electronic market place for the development of invention including the steps of "*soliciting...; making available...; facilitating delivery....; obtaining...; facilitating the development....*"; while invention of group II is directed to method of operating a marketplace for the development of inventions including the steps of "*making available.....; recording a date...; directing.....; collecting.....; identifying.....; receiving.....; partitioning.....; publishing.....; providing.....; presenting....*",

Because these inventions are independent or distinct for the reasons given above, because the search required for Group I, is not necessarily required for Groups II due to their different scope and subject, and vice versa, restriction for examination purposes as indicated is proper since it's a serious burden for the examiner to examine all of these amended claims.

3. Inventions in **Groups I and III** are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the invention of group I is directed to method of operating an electronic market place for the development of invention including the steps of *"soliciting...; making available...; facilitating delivery...; obtaining...; facilitating the development...."*; while invention of group III is directed to method operating a collaborative support system including the steps of *"making available a plurality of alternatives for a collaborative support process....; applying support process active...."*.

Because these inventions are independent or distinct for the reasons given above, because the search required for Group I, is not necessarily required for Groups III due to their different scope and subject, and vice versa, restriction for examination purposes as indicated is proper since it's a serious burden for the examiner to examine all of these amended claims.

4. Inventions in **Groups I and IV** are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the invention of group I is directed to method of operating an electronic market place for the development of invention including the steps of *"soliciting...; making available...; facilitating delivery...; obtaining...; facilitating the development...."*; while invention of group IV is directed method of

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operating an electronic idea development community including the steps of  
*"providing a share medium for interaction.....; receiving rating data....".*

Because these inventions are independent or distinct for the reasons given above, because the search required for Group I, is not necessarily required for Groups IV due to their different scope and subject, and vice versa, restriction for examination purposes as indicated is proper since it's a serious burden for the examiner to examine all of these amended claims.

5. Inventions in **Groups II and III** are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the invention of group II is directed to method of operating a marketplace for the development of inventions including the steps of *"making available.....;recording a date...; directing.....; collecting.....; identifying.....; receiving.....; partitioning.....; publishing.....; providing.....; presenting...."*, while invention of group III is directed to method operating a collaborative support system including the steps of *"making available a plurality of alternatives for a collaborative support process....; applying support process active...."*.

Because these inventions are independent or distinct for the reasons given above, because the search required for Group II, is not necessarily required for Groups III due to their different scope and subject, and vice versa, restriction for examination purposes as indicated is proper since it's a serious burden for the examiner to examine all of these amended claims.

6. Inventions in **Groups II and IV** are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the invention of group II is directed to method of operating a marketplace for the development of inventions including the steps of *"making available.....;recording a date...; directing.....; collecting.....; identifying.....; receiving.....; partitioning.....; publishing.....; providing.....; presenting...."*, while invention of group IV is directed method of operating an electronic idea development community including the steps of *"providing a share medium for interaction.....; receiving rating data...."*.

Because these inventions are independent or distinct for the reasons given above, because the search required for Group II, is not necessarily required for Groups IV due to their different scope and subject, and vice versa, restriction for examination purposes as indicated is proper since it's a serious burden for the examiner to examine all of these amended claims.

7. Inventions in **Groups III and IV** are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the invention of invention of group III is directed to method operating a collaborative support system including the steps of *"making available a plurality of alternatives for a collaborative support process.....; applying support process active...."* while invention of group IV is directed to

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method of operating an electronic idea development community including the steps of "*providing a share medium for interaction.....; receiving rating data...*".

Because these inventions are independent or distinct for the reasons given above, because the search required for Group III, is not necessarily required for Groups IV due to their different scope and subject, and vice versa, restriction for examination purposes as indicated is proper since it's a serious burden for the examiner to examine all of these amended claims.

8. Applicant is advised that the reply to this requirement to be complete must include an election of the invention, either group I, II, III or IV, to be examined even though the requirement be traversed (37 CFR 1.143).

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuy-Vi Nguyen whose telephone number is 571-270-1614. The examiner can normally be reached on Monday through Thursday from 8:30 A.M to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. N./  
Examiner, Art Unit 3689

/Tan Dean D. Nguyen/  
Primary Examiner, Art Unit 3689  
3/28/09